

REMARKS

At the time of the Office Action dated February 11, 2003, claims 1-19 were pending and rejected in this application. Claims 9-11 have been amended to correct minor informalities. Applicants submit that the present Amendment does not generate any new matter issue.

In the third enumerated paragraph of the Office Action, the Examiner asserted identified a perceived informality generating an antecedent basis issue with regard to claims 11 and 12. In response, Applicants have amended claims 11 and 12 to provide antecedent basis for the term "isolating features." Applicants, therefore, respectfully solicit withdrawal of the objection to claims 11 and 12.

Claims 1-4, 6-8 and 13-19 are rejected under 35 U.S.C. § 102(b) for lack of novelty as evidenced by Uchida et al., U.S. Patent No. 6,060,748 (hereinafter Uchida)

In the fifth enumerated paragraph of the Office Action, the Examiner asserted that Uchida discloses a semiconductor device and method of making the same corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that one having ordinary skill in the art would have recognized that the identically claimed invention is within

AED Corporation v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). Electro Medical Systems S.A. v. Cooper Life Sciences, Inc. 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

identically discloses each feature of the claimed invention.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ That burden has not been discharged.

In the statement of the rejection, the Examiner asserted that Uchida discloses "providing a silicon layer over an insulating layer 12." Although the Examiner's rejection fails to comport to the provisions of 37 C.F.R. § 1.104(c)⁴ for failing to specifically identify the claimed silicon layer, Applicants assume that the claimed silicon layer is disclosed by feature 13 (see column 10, lines 19-21). The Examiner then asserted that Uchida discloses:

partially removing the first portion of the silicon layer, wherein a thickness of the second portion (the left portion) is greater than a thickness of the first portion (the right portion). See figures 10, and column 10, lines 10-67.

Applicants respectfully disagree with the Examiner's assertion that Uchida identically discloses this particular limitation. Referring to Fig. 10C of Uchida, the right portion, which allegedly corresponds to the claimed first portion, of the insulating layer 12 is completely removed (column 10, lines 33-35). In contrast, claim 1 specifically recites that the first portion is partially removed. Furthermore, as the first (right) portion of Uchida is completely removed, this portion does not exist. Thus, a comparison of the thicknesses of the right (first) portion and the left (second) portion cannot be made. As a comparison of the thicknesses cannot be made, the

² In re Rijekaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GmbH v. American Doctor & Derrick Co., 720 F.2d 1452, 221 USPQ 181 (Fed. Cir. 1984).

references at his or her command. When a reference is complex or shows or describes an invention other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable

Examiner cannot assert that the thickness of the second (left) portion of Uchida is greater than the thickness of the first (right) portion, as recited in claims 1 and 16. Therefore, Uchida fails to identically disclose the claimed invention, as recited in claims 1 and 16, under 35 U.S.C. § 102.

With regard to claim 6, which recites that "the step of partially removing the first portion of the silicon layer includes oxidizing the first portion of the silicon layer and removing the oxidized silicon," the Examiner referred to column 10, lines 31-39 of Uchida to identically disclose this limitation. This passage, however, fails to identically disclose this limitation. Uchida does not disclose removing oxidized silicon. Instead, Uchida teaches that the silicon layer 13 is removed with a buffered hydrofluoric acid, and after the silicon layer 13 is remove., the surface of the substrate oxidized. Thus, Uchida fails to teach oxidizing the silicon layer or removing the oxidized silicon. Thus, claim 6 further distinguishes the claimed invention over Uchida.

With regard to claim 14, which recites that "the first transistor includes first source/drain regions and the second transistor includes second source/drain regions formed, and a depth of the second source drain regions greater than a depth of the first source drain regions," the Examiner referred to the disclosure of source/drain regions 19a, 19b and source/drain regions 13b in Figs. 6 and 8 of Uchida to identically disclose this limitation. However, Applicants refer the Examiner to M.P.E.P. § 2125, which states "PROPORTION OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE"

established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.⁵ In this regard, Uchida is completely silent as to the depth of source/drain regions 19a, 19b relative to source/drain regions 13b. Thus, Figs. 6 and 8 cannot be relied upon to disclose the relative depths of the first source/drain regions and the second source/drain regions recited in claim 14. Thus, claim 14 further distinguishes the claimed invention over Uchida.

Claims 5 and 9-12 are rejected under 35 U.S.C. § 103 for obviousness based upon Uchida

In the seventh enumerated paragraph of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify the methodology of Uchida to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 5 and 9-12 depend ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Uchida. Specifically, Usagawa neither discloses nor suggests partially removing the first portion of the silicon layer, wherein a thickness of the second portion is greater than a thickness of the first portion. As the Examiner has not provided a motivation for one having ordinary skill in the art to modify Uchida to arrive at this limitation, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* basis for the imposed rejection of claims 5 and 9-12 under 35 U.S.C. § 103 for obviousness. Applicants,

⁵ See, *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000). See, *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000).

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Scott D. Paul
Registration No. 42,984

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SDP:kap
Date: March 4, 2003
Facsimile: (202) 756-8087